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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,974	02/04/2004	Wing Sum Vincent Kwan	29617/CL001A	3853

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EXAMINER
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FAISON, VERONICA F

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/771,974

Applicant(s)

KWAN ET AL.

Examiner

Veronica F. Faison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4-7-05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-14,16-18,20,21 and 23-38 is/are rejected.
- 7) ☒ Claim(s) 9,15,19 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 1, 4, 5, 11, 12, 13, 16, 17, 23 have been amended, claims 37-39 have been added and claims 3 has been canceled. Hence, claims 1, 2, 4-39 are pending in the application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 5, 7, 8, 10, 14, 18, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirschfeld (US Patent 3,928,554).

Hirschfeld teaches a composition comprising an emulsion of two liquids in which a first liquid is considered a carrier solvent (assuming that it is the dispersed phase in the emulsion) and the second liquid is considered as the suspending medium (assuming that it is dispersion medium in the emulsion), wherein solvents and medium are substantially immiscible with one another and as noted (col. 2 lines 43-52). The reference further teaches one or more dispersed phases of dyes in immiscible solvents and the dyestuff that would be incompatible with one another (abstract and col. 1 line 49-col. 2 line 7). The only basic criteria for the selection of dye pairs or combination being that each selected dye of a combination is soluble in a liquid vehicle to provide a high enough concentration to achieve a saturation dyeing of the desired sample, and

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that the several vehicles in which the respective dyes are dissolved are substantially immiscible with one another or with a dispersion medium in which the respective dyes are suspended as a dispersed phase (col. 3 lines 31-39). In example 1, the reference discloses solvents that met the density difference set forth in claim 6. The reference remains silent to whether the composition is an ink composition. However, it is the position of the Examiner that composition taught by Hirschfeld has the capable to perform as an ink composition, because it discloses the same components as claimed by Applicant's ink composition. The composition as taught by Hirschfeld appears to anticipate the claimed invention. ...

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 11-13, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirschfeld (US Patent 3,928,554).

Hirschfeld is described above, but fails to teach the specific limitations of the claims above. The reference states that "the respective dyes are dissolved are substantially immiscible with one another or with a dispersion medium in which the respective dyes are suspended as a dispersed phase". Therefore it would have been obvious to one of ordinary skill in the art that any dye is usable as long as it meets the limitation of the dispersion medium, absence tangible evidence to the contrary.

Claims 23-37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbard (US Patent 3,849,143) in view of Hirschfeld (US Patent 3,928,554).

Hubbard teaches an ink storage systems for markers or marking pens with capillary nibs or ink delivery means (col. 1 lines 2-5). The capillary type of reservoir consisting of a fibrous body saturated with ink. These fibrous bodies usually consisted of cellulose acetate or polyester fibers and are usually available only in cylindrical or other very simple shapes (col. 1 lines 23-27). The reference further teaches that typically inks are comprised primarily of a solvent and a dye (col. 6 line 58+).

Hirschfeld is described above, therefore it would have been obvious to one of ordinary skill in the art to use the ink composition as taught by Hirschfeld in the ink storage system of Hubbard because Hubbard teaches that the typical ink comprises primarily of a solvent and a dye, which is what is taught by Hirschfeld.

#### ***Allowable Subject Matter***

Claims 9, 15, 19, 22 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The references alone or in combination fail to teach multi-color ink the specific combinations of solvents set forth in the claims above.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

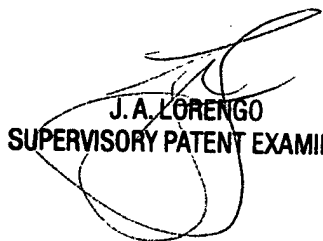
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VFF  
6-27-05

  
J.A. LORENZO  
SUPERVISORY PATENT EXAMINER